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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :  
Tsuyoshi YAMANE et al. : Docket No. 2001\_1217A  
Serial No. 09/941,693 : Group Art Unit 1762  
Filed August 30, 2001 :  
RECYCLE SYSTEM OF AQUEOUS PAINT : Confirmation No. 6192

**RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT**

Assistant Commissioner for Patents,  
Washington, D.C.

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JAN 04 2002  
PATENT & TRADEMARK OFFICE  
THIS LETTER IS DEPOSIT  
NO. 33-0976.

Sir:

The Notice of Non-Compliant Amendment mailed December 14, 2001 indicates that the Amendment filed August 30, 2001 did not include a clean version of the amended claim, and did not include a marked-up version of the amended claim. This assertion is respectfully traversed.

A copy of the Preliminary Amendment filed August 30, 2001 is enclosed, together with a copy of a marked-up version of the amended claim as also filed on August 30, 2001. Only claim 6 was amended.

Thus, it is submitted that both the clean version of the amended claim 6 and the marked-up version of the amended claim 6 were submitted on August 30, 2001. In any event, copies of thereof are enclosed.

Respectfully submitted,

Tsuyoshi YAMANE et al.

**RECEIVED**

JAN 09 2002

**TC 1700**

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APPLICATION NO.	FILING DATE	FIRST-NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,693	08/30/2001	Tsuyoshi Yamane	2001_1217A	6192

513 7590 12/14/2001  
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2033 K STREET N. W.  
SUITE 800  
WASHINGTON, DC 20006-1021

EXAMINER	
EDWARDS, LAURA ESTELLE	
ART UNIT	PAPER NUMBER

1734  
DATE MAILED: 12/14/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

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DEC 21 2001

WENDEROTH, LIND & PONACK



## UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED:

## Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment filed on 8-30-01 is considered non-compliant because it has not been submitted in the format required under 37 CFR 1.121, as amended on September 8, 2000 (see 65 Fed. Reg. 54603, Sept. 8, 2000, and 1238 O.G. 77, Sept. 19, 2000).

- ☐ 1. The amendment does not include a clean version of the replacement paragraph(s)/section(s). 37 CFR 1.121(b)(1)(ii).
- ☐ 2. The amendment does not include a marked-up version of the replacement paragraph(s)/section(s). 37 CFR 1.121(b)(1)(iii).
- ☒ 3. The amendment does not include a clean version of the amended claim(s). 37 CFR 1.121(c)(1)(i).
- ☒ 4. The amendment does not include a marked-up version of the amended claim(s). 37 CFR 1.121(c)(1)(ii).
- ☐ 5. Other \_\_\_\_\_

☒ **PRELIMINARY AMENDMENT:** Unless applicant re-submits the preliminary amendment in compliance with revised 37 CFR 1.121 within ONE MONTH of the mail date of this letter, examination on the merits may commence without entry of the originally proposed preliminary amendment. This notice is not an action under 35 U.S.C. 132, and this ONE MONTH time limit is not extendable.

- ☐ **AMENDMENT AFTER NON-FINAL ACTION:** Since the above mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

For your convenience, attached to this correspondence is a copy of an informational flyer (MPEP Bookmark Bulletin on "Simplified Amendment Practice").

*Veronica Day Everett*  
Legal Instruments Examiner

# Changes to the Patent Rules

October 20, 2000

Volume 1, Issue 3

This is the third in a series of Patent News Bulletins to assist you in keeping up to date with significant rule changes which affect your area. Keep this copy to use as a bookmark for your present MPEP, or view this bulletin again on the USPTO Website.



## Simplified Amendment Practice. Replacement paragraphs/sections/claims to be used. 37 CFR 1.121

The rule package "Changes to the Patent Business Goals - Final Rule," published in the Federal Register on September 8, 2000, 65 Fed. Reg. 54603 (Sept. 8, 2000), and the Official Gazette on September 19, 2000, 1238 Off. Gaz. Pat. Office 77 (September 19, 2000). The PBG rule package makes a number of revisions to Title 37.

The entire final rule may be found at the USPTO Website at <http://www.uspto.gov/web/offices/dcom/olla/pbg/index.html>.

Areas and individuals primarily affected by this rule change include:  
(1) Patent Examiners and Tech Support Staff in the Technology Centers  
(2) Office of Patent Publication

Any questions related to this change in practice should be directed to Joe Narcavage, Special Projects Exr., (703-305-1795) or Ltz. Dougherty, Legal Advisor, (703-306-3156) OPLA.



Mandatory compliance with the revised rule is not required until March 1, 2001. It is suggested that applicants adopt the revised procedures on or after November 7, 2000, in order to adjust to the changes in amendment practice.

Under the new amendment practice, amendments to the specification must be made by the submission of clean new or replacement paragraph(s), section(s), specification, or claim(s). This practice will provide a specification (including claims) in clean, or substantially clean, form that can be effectively captured and converted by optical character recognition (OCR) scanning during the patent printing process.

The new practice requires applicant to provide, in addition to the clean version of a replacement paragraph/section/claim, a marked-up version using applicant's choice of a conventional marking system to indicate the changes, which will aid the examiner in identifying the changes that have been made. The marked-up version must be based on the previous version and indicate (by markings) how the previous version has been modified to produce the clean version submitted in the current amendment. The term "previous version" means the version of record in the application as originally filed or from a previously entered amendment.

The following format is suggested in an amendment paper: (1) a clean version of each replacement paragraph/section/claim with clear instructions for entry; (2) starting on a separate page, any remarks/arguments (37 CFR 1.111); and (3) starting on a separate page, a marked-up

version entitled "Version with markings to show changes made."

Applicants will also be able to submit a clean set of all pending claims, consolidating all previous versions of pending claims from a series of separate amendments into a single clean version in a single amendment paper. This submission of a clean version of all of the pending claims will be construed as directing the cancellation of all previous versions of any pending claims. No marked-up version will be required to accompany the clean version where no changes other than the consolidation are being made.

The amended rule encourages issuance of applications with an examiner's amendment without practitioners/applicants having to file a formal amendment. Additions or deletions of subject matter in the specification, including the claims, may continue to be

made in an examiner's amendment at the time of allowance by instructions to make any change at a precise location in the specification or the claims. An examiner's amendment may incorporate a printed copy of a fax or e-mail amendment submitted by applicant. Only that part of the e-mail or fax directed to a clean version, or a portion of, a paragraph/claim to be added should be printed and attached to the examiner's amendment, with a paper copy of the entire e-mail or fax being entered in the file. The electronic version of the e-mail is not required to be saved once the printed e-mail (and any attachments) becomes part of the application file record.

*Amendment by  
paragraph/claim  
replacement in clean form.*

MPEP 714+ & 1302.04